

REMARKS

Introductory Comments

Reconsideration of the above-identified application in view of the above amendments and arguments set forth is respectfully requested.

Claims 59, 61, 73-76, 79-81 and 84 are pending and under consideration. Claim 72 has been canceled in this amendment. Claims 73, 79 and 84 have been amended as explained below. No new matter has been added as a result of these amendments.

Double Patenting Rejection

Claims 59, 61, 72-75, 79-81 and 84 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,004,787.

Applicants enclose herewith a terminal disclaimer in order to obviate the double patenting rejection. Accordingly, Applicants respectfully request withdrawal of the double patenting rejection.

Rejection of Claims 59, 61, 72-75, 79-81 and 84 Under 35 U.S.C. § 112, First Paragraph – Written Description

Claims 59, 61, 72-75, 79-81 and 84 (the Examiner incorrectly identified the rejected claims as 59, 60, 72-75 and 89-81) are rejected under 35 U.S.C. § 112, first paragraph as failing to provide a written description of the invention.

The Examiner states that the specification fails to teach how a generic, heterologous, host cell may survive the practice of the claimed method after transformation. The Examiner suggests amending claim 84 by reciting a polyketide-producing *Actinomycetales* cell as the host cell.

Applicants respectfully traverse the rejection.

Although Applicants disagree with the Examiner's position, in an effort to expedite prosecution of the instant claims, Applicants have amended claim 84 in

the manner suggested by the Examiner. Support for this amendment can be found on pages 2-4 and 10. Accordingly, claim 72, which contains this subject matter that has been incorporated into claim 84, has been canceled in this amendment. Additionally, claims 73 and 79 have been amended in order to correct the improper claim dependency (claim 73 previously depended on claim 72 which was canceled and claim 79 previously depended on claim 78 which was canceled).

Therefore, Applicants respectfully request withdrawal of the rejection of claims 59, 61, 72-75, 79-81 and 84 under 35 U.S.C. § 112, first paragraph as failing to provide a written description of the invention.

Applicants express their appreciation for the Examiner's suggestions. Applicants have amended the claims in every aspect of the Examiner's suggestions and therefore respectfully request passing the claims through issuance.

CONCLUSION

Applicants respectfully submit that the claims comply with the requirements of 35 U.S.C. Section 112. Accordingly, a Notice of Allowance is believed to be in order and is respectfully requested.

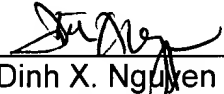
Should the Examiner have any questions concerning the above, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below. If the Examiner notes any further matters which the Examiner believes may be expedited by a telephone interview, the Examiner is requested to contact the undersigned.

Respectfully submitted,

L. Katz *et al.*

Wood, Phillips, Katz, Clark & Mortimer
500 West Madison Street
Suite 3800
Chicago, IL 60662-2511

Tel.: (312) 876-2110
Fax.: (312) 876-2020



Dinh X. Nguyen
Registration No. 54,923
Attorney for Applicants